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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,440	04/14/2000	Alfred L. Chi	11602-002002	9296
26161	7590	09/13/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/549,440

Applicant(s)

CHI, ALFRED L.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22,26,27,29,30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22,26,27,29 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-7, 11, 12, 15, 17-21, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (US Patent No. 5,883,810).

As per claims 1, 29 and 30, all the claimed features are taught by Franklin et al. The system and method enable a holder of a financial account to use an electronic communication medium 32, 34, or 36 (column 2, lines 8-10) to predefine a virtual account associated with the financial account (column 2, lines 38-47 and column 4, line 55 to column 5, line 23), the virtual account having an associated limitation on a payment to be made from the financial account (column 3, lines 12-18);

In connection with a transaction, providing information about the virtual account to a third party and in response to a request made by third party for payment using an electronic communication medium to communicate the virtual account information, preventing any payment from the financial account that is outside of the limitation associated with the virtual account (column 10, line 52 to column 11, line 49).

As per claim 2, note column 11, lines 33-49 which takes into account the merchant's identification.

As per claim 4, an expiration date is entered by the customer. Note column 11, lines 8-11 of Franklin et al.

As per claim 5, note column 10, lines 52-53 of Franklin et al where it is taught limiting a transaction number to a single use.

As per claim 6, Franklin et al teach the information about the virtual account includes a virtual account identifier. Note column 2, lines 38-46, column 8, lines 15-26 and column 11, lines 5-9 of Franklin et al.

As per claim 7, Franklin et al teach the financial account is a credit card. Note column 4, lines 3-6 and lines 34-43; and column 12, lines 28-30 and lines 50-66 of Franklin et al.

As per claim 11, the account holder presents the virtual account identifier to a third party electronically. Note column 2, lines 38-46, column 8, lines 15-26 and column 11, lines 5-9 of Franklin et al.

As per claim 12, the virtual account identifier comprises between one and sixteen letters or numbers. Note column 7, line 65 to column 8, line 26 of Franklin et al.

As per claim 15, note column 7, line 19 to column 8, line 43 of Franklin et al.

As per claim 17, note column 2, lines 22-37, column 5, lines 23-40, column 9, lines 30-48 of Franklin et al.

As per claim 18, note column 9, line 18 to column 11, line 38 of Franklin et al.

As per claim 19, note column 11, lines 11-14, column 8, lines 34-39 and figure 3 of Franklin et al.

As per claim 20, note column 7, lines 11-25 and column 10, line 66 to column 11, line 8 and column 8, lines 34-39 of Franklin et al.

As per claim 21, note column 2, lines 38-46, column 8, lines 15-26, column 11, lines 5-9 and column 8, lines 34-39 of Franklin et al.

As per claims 26-27, note column 2, lines 38-46, column 8, lines 15-26 and column 11, lines 5-9 of Franklin et al.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 16, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (US Patent No. 5,883,810).

Claim 32 contains similar limitations recited in claim 1 with the obvious difference that the claimed first party relates to the “holder” of claim 1. The claimed “second party” is similar to the “third party of claim 1. The claimed intermediary party is similar to the party where the virtual account is set up. Applicant is therefore referred to the rejection of claim 1 above, columns 8-11 and figures 1-3 of Franklin et al.

As per claims 13-14, Franklin et al teach multiple clients in their system thus implying having a multiple virtual accounts. Moreover, it would have been obvious to one of ordinary skill in the art to note that a customer or client may also hold more than one virtual account similar to a customer or client owing or possessing more than one credit card depending on their qualifications. Thus, having two of the virtual accounts associated with one financial accounts would have been obvious to one of ordinary skill in the art in order to give a customer or account holder the option of using one or more card during a particular transaction.

As per claim 16, Franklin et al do not explicitly teach enabling the cardholder to add, delete or modify the virtual account. However, it is well known in the art that a cardholder has all these options presented to him/her, and also at any time a credit cardholder may choose to cancel or delete or close his/her account which may be with or without a penalty depending on the agreed terms and conditions with the associated financial institution. It would have been obvious to one of ordinary skill in the art to note that such options would have been obvious to be presented to the customers or cardholders in the system of Franklin et al. The motivation would have been provide an attractive system to potential cardholders thus making the system more versatile.

As per claim 22, Franklin et al teach that the registration may be made using a telephone. Note column 7, lines 22-26 of Franklin et al. Franklin et al do not explicitly teach the holder has access to the virtual account through a telephone using a script in voice response system. Such would have been obvious to the skilled artisan using the same voice response system and by modifying the script therein. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Franklin et al. in order have access of the virtual account using a telephone in order to provide alternate means of using the system so as to facilitate customers not having access to a computer or the Internet.

3. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (US Patent No. 5,883,810) as applied to claims 1 above, and further in view of Carlisle et al (US Patent No. 5,649,118).

As per claims 8-9, the teachings of Franklin et al are discussed above. Franklin et al fails to explicitly teach having multiple financial accounts and the virtual accounts has associated limitations on the payments to be made from each of the financial accounts. Carlisle et al teach a smart card with multiple charge accounts and product item tables designating a particular account for debit during a transaction. Note the abstract, column 3, lines 57-64 and column 20, lines 46-63 of Carlisle et al. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Carlisle et al into Franklin et al in order to associate a virtual account with a financial account system having a plurality of financial accounts. The motivation would have been to give priority to a given account where funds are always available in order to effect a financial transaction.

4. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (US Patent No. 5,883,810) as applied to claims 1 above, and further in view of Kitchen et al. (US Patent No. 6,289,322).

As per claims 3 and 10, the teachings of Franklin et al are discussed above. Franklin et al do not explicitly teach a multiple third parties and the virtual account has associated limitations on the payments to be made to each of the third parties. However, Franklin et al illustrate and make reference to a single merchant. However, setting up payment to a plurality of merchants is well known in the art. Applicant is directed to the teachings of Kitchen et al. Kitchen et al disclose an electronic bill processing system wherein a user has the option to set up methods of payments to a plurality of merchants. Accounts of a payor or customer are linked to their checking/saving/debit accounts and automatic payment is automatically made by an

intermediary. In the system of Kitchen et al, methods of payments include the amount and the frequency of payments made to a plurality of merchant accounts. Note figures 9C, 10A and column 8, line 38 to column 9, line 15 and column 15, line 20 to column 16, line 67 of Kitchen et al. It would have been obvious to one of ordinary skill in the art at the time of the invention to introduce the teachings of Kitchen et al into Franklin et al in order to associate the virtual account to a multiple of third parties thereby making timely payments on periodically or recurring bills.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP
September 3, 2004


FRANTZY POINVIL
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